



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/725,717

11/30/2000

Dale W. Malik

BS00-168

1249

38823

7590

06/21/2006

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/  
BELLSOUTH I.P. CORP  
100 GALLERIA PARKWAY  
SUITE 1750  
ATLANTA, GA 30339

EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/725,717

Applicant(s)

MALIK, DALE W.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2,4-21,23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1,2,4-21,23-28 are pending. Claims 18,19 have been amended.

***Response to Amendment***

2. Applicant's arguments filed 5/01/06 with respect to claims 1,2,4-21,23-28 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. Claims 1-2,4-21,23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

(i.e.: applicant claimed "transmitting the outgoing email communication if the domain name is included in the incoming domain name list, OR otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication" . Examiner was unable to determine what the invention was really was).

4. Claims 1-2,4-21,23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i.e.: transmitting the outgoing email communication if the domain name is included in the incoming domain name list, OR otherwise generating a prompt for a user

Art Unit: 2142

to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication. It was unclear the option claimed may or may be not included).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4-21,23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul [6,052,709].

5. As per claim 1, Paul discloses a method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication [Paul, controlling delivery of unsolicited email, abstract], comprising:

creating an incoming domain name list in a memory [Paul, an exclusion list manager, col 5 line 63-col 6 line 16, Fig 2]; receiving an incoming email communication [Paul, incoming email, col 8 lines 1-32];

extracting a domain name from a sender's email address from the incoming email communications [Paul, extracts the source header, compare the domain, col 5 lines 1-45];

storing the domain name in the incoming domain name list in the a memory [Paul, stored exclusion list, col 6 lines 1-25];

checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming domain name list in the memory [Paul, Filter or compare the domain of message, col 5 lines 34-45; col 7 lines 15-35; col 8 lines 1-67]; and

transmitting the outgoing email communication if the domain name is included in the incoming domain name list [Paul, forward to the user's respective user sites, col 8 lines 45-55],

(OR) otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication [Paul, alert signal, col 5 lines 20-32].

6. As per claim 2, Paul discloses extracting a domain name from each e-mail address provided in the outgoing e-mail communication, wherein the e-mail communication is transmitted after checking each extracted domain name in the list of domain names, and confirming each e-mail address for which the extracted domain name is not included in the incoming domain name list [Paul, extract data, data analyzed, col 5 lines 1-32].

7. As per claim 4, Paul discloses receiving a corrected e-mail address from the user in response to the prompt; and repeating the steps of checking a corrected domain name and generating a prompt if the corrected domain name is not included in the incoming domain name list, until the user either confirms that the domain name

provided in the e-mail address is correct or provides a domain name that is in the list of domain names [Paul, extract data, data analyzed, alert signal, col 5 lines 1-32].

8. As per claim 5, Paul discloses the outgoing e-mail communication is intercepted in an e-mail server to check the domain name in the e-mail address prior to transmission [Paul, filtering outgoing message, col 8 lines 1-32].

9. As per claim 6, Paul discloses the prompt is an e-mail message from the e-mail server to the user [Paul, alert signal, col 5 lines 1-32].

10. As per claim 7, Paul discloses the prompt is a network message to the user [Paul, alert signal, col 5 lines 1-32].

11. As per claims 21,23-25 contain the similar limitations as set forth in claims 1-2,4-7. Therefore claims 21,23-25 are rejected by the same rationale set forth claims 1-2,4-7.

12. As per claim 8 Paul discloses A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

receiving email communications incoming to the email communications server;  
creating a domain name database [Paul server, Fig 1; domain source, col 5 lines 34-45;  
database, col 9 lines 5-12];

extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server; storing extracted domain names in the domain name database [Paul, extract, col 5 lines 1-45];

receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network [Paul incoming and outgoing message, col 8 lines 1-67];

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication routed in the outgoing e-mail communications [Paul, filter and compare the incoming and outgoing message, col 8 lines 1-67];

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled [Paul, alert signal, col 5 lines 21-32].

13. As per claim 9, Paul discloses searching for similarly spelled domain names is performed by checking each alphanumeric character comprised in the extracted domain name with the alpha-numeric characters (i.e.: text) comprised in the domain names in the database, and detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain [Paul, database, col 9 lines 5-12; similar text, col 6 lines 45-58].

Art Unit: 2142

14. As per claim 10, Paul discloses searching for similarly spelled domain names is performed by removing an alpha-numeric character from the extracted domain name and searching the domain name database for a domain name consisting of at least each of the remaining alphanumeric characters in the extracted domain name [Paul, extract data, data analyzed, alert signal, col 5 lines 1-32].

15. As per claim 11, Paul discloses searching for similarly spelled domain names is performed by comparing the extracted domain name with reference domain names stored in the domain name database according to predetermined spelling grammar algorithms [Paul, extract data, data analyzed, alert signal, col 5 lines 1-32].

16. As per claims 12,13 Paul discloses the error prompt is an e-mail message from the e-mail server to the client computer transmitting the e-mail communication [Paul, Fig 1].

17. As per claim 14, Paul discloses determining whether extracted domain names are already stored in the domain name database, whereby only a single copy of an extracted domain name is stored in the domain name database as inherent feature of database.

18. As per claim 15, Paul discloses storing tally information in the domain name database to tally the frequency in which domain names in the domain name database



Art Unit: 2142

are extracted from incoming e-mail communications as inherent feature of domain list or database.

19. As per claim 16, Paul discloses deleting domain names from the domain name database that are not frequently extracted from incoming e-mail communications according to respective tally information as inherent feature of domain list or database.

20. As per claim 17, Paul discloses the tally information for each domain name in the domain name database includes the calendar date in which the domain name was most recently extracted as inherent feature of domain list or database.

21. As per claims 18-20 contain the similar limitations as set forth in claims 8-17. Therefore claims 18-25 are rejected by the same rationale set forth claims 8-17.

22. As per claim 18 An e-mail server for automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

an interceptor (i.e.: filter) for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications [Paul, filter and compare the domain, col 5 lines 34-45; incoming and outgoing message, col 8 lines 1-55];

a database generator for generating a domain name database for storing domain names extracted from sender's e-mail addresses in incoming e-mail communications [Paul, database, col 9 lines 5-12]; and

a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications [Paul, similar text, col 6 lines 45-58], wherein the e-mail server prompts the user when it detects misspelled domain names in e-mail addresses in outgoing e-mail communications [Paul, alert signal, col 5 lines 21-32].

23. As per claim 26, Paul discloses an e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

an address extractor for extracting senders' e-mail addresses from incoming e-mail communications [Paul, filter and compare the domain, col 5 lines 34-45; incoming and outgoing message, col 8 lines 1-55];

a previous sender addresses memory for storing e-mail addresses extracted from senders' e-mail addresses in incoming e-mail communications [Paul, earlier source in server listed, col 5 lines 34-45]; and

a checker for searching the previous sender addresses memory for e-mail addresses of intended recipients of the that are provided in outgoing e-mail communications [Paul, earlier source in server listed, col 5 lines 34-45], wherein the

Art Unit: 2142

checker generates a prompt for verification of an email address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory [Paul filter or compare the incoming and outgoing message or domain of message, col 5 lines 34-45; col 7 lines 15-35; col 8 lines 1-67].

24. As per claim 27, Paul discloses the previous sender addresses memory is included in an e-mail address directory [Paul, earlier source in server listed, col 5 lines 34-45].

25. As per claim 28, Paul discloses the e-mail address directory additionally stores user-specified e-mail addresses [Paul, an exclusion list manager, col 5 line 63-col 6 line 15].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
*Primary Examiner*  
*Art Unit 2142*

